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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/705,125	11/01/2000	Hitoshi Miyasaka	EITCP003HO	4127

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EXAMINER

CAMPBELL, JOSHUA D

ART UNIT PAPER NUMBER

2179

DATE MAILED: 09/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/705,125

Applicant(s)

MIYASAKA ET AL.

Examiner

Joshua D Campbell

Art Unit

2179

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/27/2004 ✓
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: Amendment filed on 05/17/2004
IDS filed on 04/27/2004.
2. Claims 1-27 are pending in this case. Claims 1, 10, and 19 are independent
claims. Claims 28-30 have been cancelled.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that
form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 5-8, 10, 14-17, 19, and 23-26 remain rejected under 35 U.S.C. 102(e)
as being anticipated by Nehab et al. (hereinafter Nehab, US Patent Number 6,029,182,
issued on February 22, 2000).

Regarding independent claim 1, Nehab discloses a method in which a user generates a profile containing information including layout, sites to check, keywords, and types of articles to be used to create a personalized newspaper (column 9, 4-61 of Nehab). This profile is obtained and used to find (identify) documents and articles that fit into the user preferences (relevance based on keywords, type of article, topic of

article, etc.) (column 8, line 10-column 9, line 61 of Nehab). Nehab discloses a method in which the articles that are deemed relevant based on the user profile are presented (generating a list) to the user and a format editor gives the user the ability to decide which articles are to be place in the newspaper and how they are to be laid out in the template (column 9, line 4-column 10, line 6). The articles that have been obtained because they were deemed relevant are then placed into a template based on the user's specification of layout (column 9, line 4-column 10, line 6).

Regarding dependent claims 5-7, Nehab discloses a method in which documents are ranked based on their relevance based on keywords (measure of satisfaction based on keywords). This ranking is based on structural criteria in which the frequency of keywords and Boolean combinations of keywords are taken into consideration (column 8, line 10-column 9, line 61 of Nehab).

Regarding dependent claim 8, Nehab discloses a method in which a template can be selected from a list of preexisting templates (column 8, lines 10-45 of Nehab).

Regarding independent claim 10 and dependent claims 14-17, the claims incorporate substantially similar subject matter as claims 1 and 5-8. Thus, the claims are rejected along the same rationale as claims 1 and 5-8.

Regarding independent claim 19 and dependent claims 23-26, the claims incorporate substantially similar subject matter as claims 1 and 5-8. Thus, the claims are rejected along the same rationale as claims 1 and 5-8.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 2-4, 11-13, and 20-22 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Nehab et al. (hereinafter Nehab, US Patent Number 6,029,182, issued on February 22, 2000) as applied to claims 1, 10, and 19 above, and further in view of Ferguson (IDS, US Patent Number 5,649,186, issued on July 15, 1997).

Regarding dependent claim 2, Nehab does not disclose method in which the relevant articles are presented in the form of a description and a link. However, Ferguson discloses a method in which the articles deemed relevant are provided in a list format containing simply the title and a link to the article for all categories chosen to be relevant (column 6, lines 1-35 of Ferguson). It would have been obvious to one of

ordinary skill in the art at the time the invention was made to have combined the method of Nehab with the method of Ferguson because it would have allowed for quicker browsing of articles, based on title not full-text.

Regarding dependent claim 3, Nehab does not disclose that the list of entries is a link to a document containing a list. However, Ferguson discloses a method in which the list is an HTML document containing links (column 6, lines 1-35 of Ferguson). It was well known at the time the invention was made to provide links to HTML documents to be viewed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of Nehab with the method of Ferguson because it provides the user with easier access because HTML documents are widely viewable with many different programs.

Regarding dependent claim 4, Nehab discloses that the documents can be delivered by automatically printing them (column 10, lines 21-35 of Nehab).

Regarding dependent claims 11-13, the claims incorporate substantially similar subject matter as claims 2-4. Thus, the claims are rejected along the same rationale as claims 2-4.

Regarding dependent claims 20-22, the claims incorporate substantially similar subject matter as claims 2-4. Thus, the claims are rejected along the same rationale as claims 2-4.

8. Claims 9, 18, and 27 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Nehab et al. (hereinafter Nehab, US Patent Number 6,029,182,

issued on February 22, 2000) as applied to claim 1, 10, 19, and 28 above, and further in view of Herz (IDS, US Patent Number 6,029,195, issued on February 22, 2000).

Regarding dependent claim 9, Nehab discloses a method in which a user generates a profile containing information including layout, sites to check, keywords, and types of articles to be used to create a personalized newspaper (column 9, 4-61 of Nehab). This profile is used to find documents and articles that fit into the user preferences (relevance based on keywords, type of article, topic of article, etc.) (column 8, line 10-column 9, line 61 of Nehab). Nehab discloses a method in which the articles that are deemed relevant based on the user profile are presented to the user and a format editor gives the user the ability to decide which articles are to be placed in the newspaper and how they are to be laid out in the template (column 9, line 4-column 10, line 6). The articles that have been obtained because they were deemed relevant are then placed into a template based on the user's specification of layout (column 9, line 4-column 10, line 6). Nehab does not disclose a method in which advertisements would be considered as a type of article. However, Herz, discloses a method in which advertisements are handled the same as articles in a personalized newspaper system (column 66, line 65-column 68, line 21). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of Nehab with the method of incorporated advertisements into the personalized newspaper of Herz because it would have provided more of the functionality of an in-print newspaper in the personalized paper.

Regarding dependent claim 18, the claim incorporates substantially similar subject matter as claim 9. Thus, the claim is rejected along the same rationale as claim 9.

Regarding dependent claim 27, the claim incorporates substantially similar subject matter as claim 9. Thus, the claim is rejected along the same rationale as claim 9.

Response to Arguments

9. Applicant's arguments filed 05/17/2004 have been fully considered but they are not persuasive. Regarding the arguments that Nehab does not disclose or suggest step (c) that generates and delivers to the recipient a list of entries corresponding to identified documents, does not disclose (d) that receives from the recipient an indication of which entries in the list have been selected by the recipient and does not disclose step (e) that obtains content information from the identified documents that correspond to the selected entries, on page 8 and 9 in reference to claims 1, 10, and 19, the examiner respectfully disagrees. As shown in the rejection above, Nehab discloses a method in which a list of articles found is generated and stored as part of the user profile (column 9, lines 35-43, column 9, line 61-column 10, line 6, and column 10, lines 21-35). As disclosed by Nehab the user may use this list to select and identify the articles that the user would like to be incorporated in the personalized newspaper (column 9, line 62-column 10, line 6 of Nehab). Once the selection is made the

newspaper is created based on at least part of the content of the document (column 9, lines 35-43 and column 10, lines 14-44 of Nehab).

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

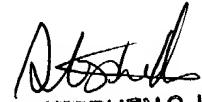
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D Campbell whose telephone number is (571) 272-4133. The examiner can normally be reached on M-F (8:00 AM - 4:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2179

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JDC
August 27, 2004


STEPHEN S. HONG
PRIMARY EXAMINER